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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/973,416      | 11/14/1997  | MORIO HARA           | 13700-0176          | 6879             |

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01/10/2003

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 01/10/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/973,416

Applicant(s)

HARA ET AL.

Examiner

Kevin R Krueer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 20-22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-13, 22 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method of producing a resin composition, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 30.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13, 22 and 24-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure for the limitation that the hydrophilic reducing organic compound and the hydrophilic and water insoluble thermoplastic resin compound should be kneaded with the hydrophobic thermoplastic resin "at a temperature lower than the melting temperature of the water insoluble thermoplastic resin compound and equal to or higher than the melting temperature of the hydrophobic thermoplastic resin."

### ***Response to Arguments***

Applicant's arguments filed November 7, 2002 have been fully considered but they are not persuasive.

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The rejections based upon Koyama, Bettel, Logan, Itamura, and Hekal have been overcome by amendment, because the references do not teach a resin/pellet made by the claimed method limitations. The claimed method limitations distinguish the claimed resin composition and pellet from the prior art resin compositions/pellets because the claimed method limitations would result in a product that is materially different from a product made by the methods disclosed in the above-mentioned references. The claimed resin compositions would comprise non-melted hydrophilic particles dispersed as isolated "islands" within the hydrophobic resin. The examiner understands that the hydrophilic resin is "non-melted" because each independent claim states that the hydrophilic reducing organic compound and the hydrophilic and water insoluble thermoplastic resin compound should be kneaded with the hydrophobic thermoplastic resin "at a temperature lower than the melting temperature of the water insoluble thermoplastic resin compound and equal to or higher than the melting temperature of the hydrophobic thermoplastic resin." The claimed pellets would comprise distinct layers: an inner layer comprising the hydrophilic resin and an outer layer comprising the hydrophobic resin. The above-mentioned primary references teach melting the hydrophilic and the hydrophobic resins together, and then forming pellets. Thus, the resin composition of the prior art does not contain non-melted hydrophilic resin, and the prior art pellets do not comprise distinct layers of hydrophilic and hydrophobic resins.

Applicant argues that the newly claimed method limitations make the claimed composition patentable. However, the original disclosure does not have support for the

limitation that the hydrophilic reducing organic compound and the hydrophilic and water insoluble thermoplastic resin compound should be kneaded with the hydrophobic thermoplastic resin "at a temperature lower than the melting temperature of the water insoluble thermoplastic resin compound and equal to or higher than the melting temperature of the hydrophobic thermoplastic resin." Applicant argues that support may be found on pages 6, 12, and 15 of the specification. However, the examiner cannot find any explicit or implicit support for the above-mentioned method limitation.

Applicant further argues unexpected results. However, Applicant's arguments are not commensurate in scope with the claimed invention. Applicant's data attempts to show the difference between a resin particle manufactured according to the disclosed method, and a particle manufactured according to the teachings of the prior art. While Shozo Shimizu's declaration argues that unexpected results will be observed in pellet, composition, or film form, Applicant's arguments cannot take the place of evidence. Thus, there is no evidence on record with regards to the claimed resin composition.

With respect to the "pellet" claims, the examiner does not consider the results unexpected. Specifically, one of ordinary skill in the art would expect that the hydrophobic layer would prevent water from reaching the hydrophilic layer. Since water does not reach the hydrophilic layer, the oxygen permeability of said layer does not increase, thus allowing more oxygen to be absorbed. In the comparative examples, the hydrophilic and hydrophobic resins of the claimed composition are kneaded together above the melting point of each resin. When such a kneaded composition is pelletized, some of the hydrophilic resin will be on the exterior of the pellet. One of ordinary skill in

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the art would expect the reducing agent to be contained within the hydrophilic resin due to their intermolecular attraction to one another. Thus, when said pellet is contacted with water, the oxygen permeability of the exposed hydrophilic resin is increased which allows for more oxygen to be absorbed by the reducing agent. Thus, Applicant's arguments are not persuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

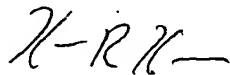
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is (703) 305-0025. The examiner can normally be reached on Monday-Friday from 7:00 a.m. to 4:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703)305-5436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Kevin R. Kruer  
Patent Examiner



Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700